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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,496	11/28/2000	Zaid Joyyosi	02481:1691-00	6965

7590 03/28/2003
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
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WASHINGTON, DC 20005-3315

EXAMINER
LIU, HONG

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 03/28/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicant(s) JOYYOSI ET AL.
	Art Unit 1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 13 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-94 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) 94 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 3-6,8,10-13,16-19,22,24-26,28-38,40-48,50-88 and 90-93.

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DETAILED ACTION

Claims 1-94 are pending in this application.

This action is in response to the applicants' amendment and reply filed on February 13, 2003.

Response to Arguments

Applicants' arguments filed February 13, 2003 have been fully considered but they are not persuasive. Rejections to claims under 35 U.S.C. 112, second paragraph and 102(b) are maintained.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

The rejection to claims 10, 11, and 13 under 35 U.S.C. 112, second paragraph, is maintained for reasons already made of record in the previous office action. Applicants argue that there are representative substituent groups for the definition of "optionally substituted." However, these are only examples with a limited number of species. The term "optionally substituted," "heterocyclyl," "heteroaryalkyl" in the claim is much broader than the limited substituents the specification discloses. Reading a claim in light of the specification is different from reading limitations of the specification into the claim. See *In re Prater*, 415 F.2d 1393, 162 USPQ 541. These claims themselves do not carry the limitation as specified in the specification. When the claims having these phrases are given the broadest interpretation, it is still open-ended in terms of the nature and number of the substituents.

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Claim Rejections - 35 USC § 102

Claims 1, 2, 7, 9, 14, 15, 20, 21, 23, 27, 39, 49, 89 remain rejected under 35

U.S.C. 103(b) as being unpatentable over Huang et al. (US 5,051,427). Applicants arguments have been fully considered but they are not persuasive. Applicants' argue that applicants' viable "B" in formula (I) is -O-, -S-, -SO-, SO₂-, NR₁₇-, a chemical bond, thynylene, -C(O)-, N(R₁₈)C(O), or -C(O)NR₁₈- whereas Huang's corresponding group is -(C)_dR₁R₂- wherein d cannot be 0. In other words, there must be an alkylene group connecting the two rings in Huang. While it is true that applicants' "B" definition does not contain an alkylene group, B is not the only variable that connects Ar II and Ar III. When "B" is a bond and "c" or "d" is 1, the two rings can still be linked by an alkylene group. Thus, the reference compounds still anticipate applicants' compounds.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

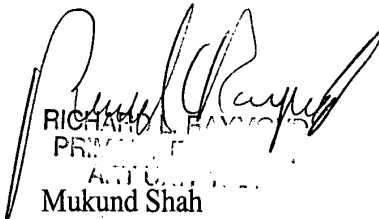
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. The examiner can normally be reached on Monday through Friday from 8:30 AM to 6:00 PM. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for this group is (703) 308-4734 for "unofficial" purposes and the actual number for official business is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose number is (703) 308-1235.

hl
March 27, 2003


RICHARD L. HANCOCK
PRINCIPAL EXAMINER
ART UNIT 1624
Mukund Shah
Supervisory Patent Examiner
Art Unit 1624